L Number	Hits	Search Text	DB	Time stamp
2	31	492/$.ccls. and "rotary printing press"	USPAT; US-PGPUB; EPO; JPO; DERWENT; IBM_TDB	2003/03/31 07:17
12	29	((29/895-895.33).CCLS.) and "printing press"	USPAT; US-PGPUB; EPO; JPO; DERWENT; IBM_TDB	2003/03/31 07:46
37	45	(fins or finned or fin) and 492/$.ccls.	USPAT; US-PGPUB; EPO; JPO; DERWENT; IBM_TDB	2003/03/31 08:43
39	284	(fins or finned or fin) near (roller or roll)	USPAT; US-PGPUB; EPO; JPO; DERWENT; IBM_TDB	2003/03/31 08:47
40	22	"finned roller"	USPAT; US-PGPUB; EPO; JPO; DERWENT; IBM_TDB	2003/03/31 08:48

Searched above MJ March 30, 2003

2111.02 Weight of Preamble

PREAMBLE IS NONLIMITING UNLESS IT BREATHES LIFE AND MEANING INTO THE CLAIM

The preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (discussed below). In claims directed to articles and apparatus, any phraseology in the preamble that limits the structure of that article or apparatus must be given weight. *In re Stencel,* 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987) (discussed below). On the other hand, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) (process claims, discussed below); *Kropa v. Robie,* 187 F.2d at 152, 88 USPQ at 481 (claims directed to apparatus, products, chemical structure, etc., as discussed below).

In *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976), the claim preamble set forth "A process for preparing foods and drinks sweetened mildly, and protected against discoloration, Streckler's reaction, and moisture absorption." The body of the claim recited two steps directed to the formation of high purity maltose and a third step of adding the maltose to foods and drinks as a sweetener. The court held that the preamble was only directed to the purpose of the process, the steps could stand alone and did not

depend on the preamble for completeness.

In *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), a preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court said that "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.' " *Id.* at 481, 187 F.2d at 152. Therefore, the preamble served to further define the structure of the article produced.

In *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987), the claim was directed to a driver for setting a joint of a threaded collar. The claim did not directly include the structure of the collar as part of the claimed article. The preamble did set forth the structure of the collar but the examiner had not given this recitation any weight. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. The court stated that "the framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited." *Id.* at 1073, 828 F.2d at 754.

COMPOSITION CLAIMS — THE PREAMBLE IS GENERALLY NONLIMITING IF THE PREAMBLE MERELY RECITES AN INHERENT PROPERTY

When the claim is directed to a product, the preamble is generally nonlimiting if the body of the claim is directed to an old composition and the preamble merely recites a